



PATENT

Attorney Docket No.: A-58762-9/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Examiner: S. ZITOMER
MEADE, et al.)
Serial No.: 09/306,749)
Filed: May 7, 1999)
For: NUCLEIC ACID MEDIATED)
ELECTRON TRANSFER)

)

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on DEC 9 - 1999

Signed: Todd V. Leone
Todd V. Leone

TERMINAL DISCLAIMER
TO OBVIATE A DOUBLE PATENTING REJECTION

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

Petitioner, **The California Institute of Technology** (hereinafter "Caltech"),

represents that it is the assignee of the entire right, title, and interest of

- (1) the instant application, Serial No. 09/306,749, filed May 7, 1999, which is a continuing application of Serial No. 08/873,598, filed June 12, 1997, now U.S. Patent No. 5,952,172; which is a continuing application of Serial No. 08/660,534,

- filed June 7, 1996, now U.S. Patent No. 5,770,369; which is a continuing application of Serial No. 08/475,051, filed June 7, 1995, now U.S. Patent No. 5,824,473; which is a continuing application of Serial No. 08/166,036, filed December 10, 1993, now U.S. Patent No. 5,591,578;
- (2) U.S. Patent No. 5,591,578, issued January 7, 1997;
- (3) U.S. Patent No. 5,824,473, issued October 20, 1998, which is a continuing application of Serial No. 08,166,036, filed December 10, 1993, now U.S. Patent No. 5,591,578;
- (4) U.S. Patent No. 5,770,369, issued June 23, 1998, which is a continuing application of Serial No. 08/475,051, filed June 7, 1995, now U.S. Patent No. 5,824,473; which is a continuing application of Serial No. 08/166,036, filed December 10, 1993, now U.S. Patent No. 5,591,578;
- (5) U.S. Patent No. 5,705,348, issued January 6, 1998, which is a continuing application of Serial No. 08/166,036, filed December 10, 1993, now U.S. Patent No. 5,591,578;
- (6) U.S. Patent No. 5,780,234, issued July 14, 1998, which is a continuing application of Serial No. 08/166,036, filed December 10, 1993, now U.S. Patent No. 5,591,578;
- (7) U.S. Patent No. 5,952,172, issued September 14, 1999, which is a continuing application of Serial No. 08/660,534, filed June 7, 1996, now U.S. Patent No. 5,770,369; which is a continuing application of Serial No. 08/475,051, filed June 7, 1995, now U.S. Patent No. 5,824,473; which is a continuing application of

Serial No. 08/166,036, issued December 10, 1993, now U.S. Patent
No. 5,591,578; and,

(8) Co-pending Patent Application Serial No. 09/100,507.

Assignments are recorded in the United States Patent and Trademark Office for U.S.S.N. 08/166,036 at Reel/Frame 6862/0211; for U.S.S.N. 08/475,051 at Reel/Frame 7660/0201; for U.S.S.N. 08/660,534 at Reel/Frame 8093/0509; and for U.S.S.N. 08/873,598 at Reel/Frame 8866/0897. Copies of the assignments are attached to this Terminal Disclaimer.

Caltech hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§154-156 and 173, as presently shortened by any terminal disclaimer, of prior Patent Nos. 5,591,578; 5,824,473; 5,770,369; 5,705,348; 5,780,234; and, 5,952,172.

Caltech further hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number 09/100,507, filed on June 19, 1998 and which would extend beyond the expiration date of copending Patent Application No. 09/100,507.

Caltech hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patents are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Caltech does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§154-156 and 173 of prior Patent Nos. 5,591,578; 5,824,473; 5,770,369; 5,705,348; 5,780,234; and, 5,952,172, as presently shortened by any terminal disclaimer, in the event that any or all of the prior patents later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued, or is any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

In addition, in making the above disclaimer, Caltech does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

The undersigned is empowered to act on behalf of the petitioner/assignee. The undersigned has reviewed the evidentiary documents in the chain of title of the present application identified above, and certifies that, to the best of assignee's knowledge and belief, title is in the assignee Caltech.

I, the undersigned, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that willful, false statements may jeopardize the validity/enforceability of the application or any patent issued thereon.

Dated: 02 December, 1999

By: 
Adam Cochran

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